

Attorney Docket No. 9400-31 (030089)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Harry Michael Schell
Application No.: 10/627,110
Filed: July 25, 2003

Confirmation No.: 3761
Examiner: Laurie Anne Ries
Group Art Unit: 2176

For: METHODS AND COMPUTER PROGRAM PRODUCTS THAT CONDITIONALLY
ROUTE PRINT FILES

April 3, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

The present Reply Brief is being filed to address the issues raised in the Examiner's Answer of February 5, 2009. The Examiner responds to Appellant's Brief on Appeal of January 5, 2009 beginning on page 11 of the Examiner's Answer. Appellant submits that the Examiner's arguments contain numerous errors which are addressed below in the particular order that they are presented by the Examiner.

The Examiner's Answer raises no new arguments that rebut the explanation provided in Appellant's Brief on Appeal of January 5, 2009 as to why many of the dependent claims provide independent basis for patentability, so Appellant incorporates by reference that explanation herein without further remarks.

For at least the reasons explained in Appellant's Brief on Appeal and the present Reply Brief, Appellant requests reversal of the rejections of the claims, allowance of the claims and passing of the application to issue.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 50-0220.

I. The Examiner's Answer Fails to Provide a Prima Facie Case of Obviousness of Claims 6 and 16 over Tanaka:

Appellant submits that the Examiner's arguments for rejecting Claims 6 and 16 as obvious over Tanaka are based on two fundamental misunderstandings of Tanaka's disclosure.

First, the Examiner argues that "Appellant has applied a narrow definition of 'print file' that is not supported by Appellant's Specification." Appellant respectfully disagrees. Claims 6 and 16 both recite, *inter alia*, "evaluating content of at least one print file based on a routing policy, wherein the print file is configured by an application for printing on a printer device". Consequently, the term "print file" used in Claims 6 and 16 must be construed to mean a file that is "configured by an application for printing on a a printer device." The Examiner then argues that the "settings file, as taught by Tanaka, may be printed on a printer device in that they contain printable data, such as 'magazine A' and 'privilege service 1' representing text data contained within the settings file (see Tanaka, Page 3, paragraph 0045)." However, the Examiner's argument is unsupported by Tanaka's paragraph 0045, which follows for convenience of reference:

FIG. 6 is the Web page displayed on the personal computer 10 by the service provision unit 130. As has been described above, the content of the setting file A of the client application comprises "magazine A" as the distribution route information, "privilege service 1" as the name of the privilege service, and "Jan. 1 to 10, 2002" as the effective period of the privilege service. Therefore, the service provision unit 130 searches the distribution route database 115, and selects two of the distribution route services "1 free print per 10 prints" and "displaying a banner advertisement of the magazine A". Since the name of the privilege service included in the setting file A is "privilege service 1", the service provision unit 130 searches the privilege service database 120 to select the privilege service 1, "5 free prints". However, the service provision unit 130 confirms the information on the effective period "Jan. 1 to 10, 2002" attached to the setting file A, and recognizes that the effective period for the user of the client application has expired. Therefore, the service provision unit 130 displays on the personal computer 10 the content of the services and a "Upload Print Images" button for uploading the image data to be printed, as shown by the page in FIG. 6. (Tanaka, paragraph 0045, emphasis added).

Accordingly, Tanaka's paragraph 0045 describes that the content of the setting file A is used to select a printer, to select a number of free prints that are authorized for use on that printer, and to display an associated user selectable "Upload Print Image" button for uploading the image data to be printed." Nowhere in paragraph 0045 or elsewhere does

Tanaka describe that the content of the setting file A is printed, instead its content is used to make printer services available for use if a user chooses to upload and print an entirely separate image file of the user's own choosing.

Appellant therefore submits that for at least these reasons and for the further reasons explained in Appellant's Brief on Appeal that the Examiner's rejections are based on clear error in the understanding of Tanaka's disclosure, and that Tanaka does not disclose the recitation of Claims 6 and 16 of "evaluating content of at least one print file based on a routing policy, wherein the print file is configured by an application for printing on a printer device."

Second, the Examiner misunderstands Tanaka's disclosure when finding that it discloses "*selectively routing the print file based on the evaluated content of the at least one print file to a non-printer device instead of to a printer device in response to the evaluated content of the print file*". The Examiner has not identified where Tanaka discloses that the image file (print file) is selectively routed to a non-printer device instead of being printed by the printer server and, much less, where it discloses such selective routing in response to evaluation of the content of the image file. The Examiner correctly contends that "Tanaka teaches that the settings file contains text data such as 'magazine A' and 'privilege service 1'", but the Examiner then erroneously contends that "Tanaka further teaches that this information is used to determine the distribution route information, such as uploading the data to a personal computer rather than sending it to a printer device (See Tanaka, Pages 3-4, paragraphs 0045-0046)." The Examiner's second contention is unsupported by Tanaka's paragraphs 0045-0046, with para. 0045 shown above and para. 0046 shown below:

[0046] FIG. 7 is a Web page displayed by the service provision unit 130 after the user of the personal computer 10 clicks the "Upload Print Images" button in the page shown in FIG. 6 for uploading the image data.

Accordingly, Tanaka's paragraph 0045 describes that the "'Upload Print Images" button" is either displayed or not displayed depending upon the authorization provided by the "settings file", and paragraph 0046 describes that image data file is only uploaded in response to a "user of the personal computer 10 click[ing] the 'Upload Print Images' button" when it is displayed. Nowhere in paragraphs 0045-0046 nor elsewhere does Tanaka disclose that the image file is selectively routed to a non-printer device instead of being printed by the print server (100) in response to evaluation of the content of the image file based on a routing

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policy. Instead, Tanaka either displays or does not display the "Upload Print Images" button" based on the authorization provided by the "settings file" to enable a user to upload and print an image file.

For at least these reasons, Appellant submits that a *prima facie* case of obviousness of Claims 6 and 16 has not been made in the Final Office Action and the Examiner's Answer. Appellant therefore requests reversal of the rejection of Claims 6 and 16 under 35 USC §103(a) and allowance thereof.

II. The Examiner's Answer Fails to Provide a Prima Facie Case of Obviousness of Claim 21 over Berard in view of Tanaka and Madison:

Claim 21 recites (emphasis added):

21. A method of routing print files in a computer system, the method comprising:

searching content of a print file to identify one or more keywords that are defined by a routing policy, wherein the print file is configured by an application for printing on a printer device; and

selectively renaming the print file based on identifying the one or more keywords in the print file instead of routing the print file to a printing device.

Accordingly, Claim 21 recites that the print file is configured by an application for printing on a printing device, and that the *print file is selectively renamed based on identifying one or more keywords contained in the print file that are defined by a routing policy, instead of routing the print file to a printing device.*

Appellant submits that the Examiner's arguments for rejecting Claim 21 as obvious over Berard in view of Tanaka and Madison contain numerous errors which are addressed below in the particular order that they are presented by the Examiner.

On page 12 of the Examiner's Answer, the Examiner erroneously construes Tanaka's "settings file" as being a print file, further misconstrues Tanaka as teaching that a print file is routed in response to keywords contained in the print file. The Examiner argues on page 12 that "Tanaka teaches a print file as discussed above in relation to claims 6 and 16." However, as explained above, the Examiner is misconstruing Tanaka's "settings file" as a print file, which it clearly is not. Tanaka clearly describes that what is printed is a separate "image file"

that can be uploaded by a user depending upon whether or not the settings file triggers the ""Upload Print Images"" button" to be displayed.

The Examiner further argues on page 12 that "Tanaka further teaches searching the contents of the profile to identify keywords defining a routing policy, such as the distribution route information, name, and privileges service (See Tanaka, Page 3, paragraph 0040."

Tanaka's paragraph 0040 is repeated below:

[0040] FIG. 3 is a block diagram showing a configuration of a print server 100 used in the printing service system in this embodiment. As shown in FIG. 3, the print server 100 comprises a communication unit 105, a distribution route service database 115, a privilege service database 120, a setting file analysis unit 110, a service provision unit 130, a printing execution unit 140, and an invoicing unit 150. The communication unit 105 carries out communication with the personal computers 10 and 20 and the printing apparatuses 50 in the mini-laboratories via the Internet 30. The distribution route service database 115 stores the content of services provided according to distribution routes of the client application (hereinafter referred to as the distribution route services). The privilege service database 120 stores the content of privilege services. The setting file analysis unit 110 reads and analyzes the setting files A and B sent from the personal computers 10 and 20. The service provision unit 130 displays in a Web page the content of one or more of the distribution route services and the privilege services selected from the distribution route service database 115 and the privilege service database 120 according to the distribution route information and the name of the privilege service analyzed by the setting file analysis unit 110. The service provision unit 130 also receives a printing order. The printing execution unit 140 sends via the communication unit 105 the image data regarding which the printing order is received by the service provision unit 130 and printing setting such as a quantity and a print size regarding the image data to one of the printing apparatuses 50 for printing (hereinafter referred to as the printing apparatus 50). The invoicing unit 150 invoices a user according to the content of the printing order received by the service provision unit 130, based on the content of the selected distribution route service or services and the selected privilege service or services. The service provision unit 130 has an image data storage unit for storing the image data uploaded by the user at the time the user places the printing order.

Tanaka's paragraph 0040 describes a print server 100 that reads and analyzes the setting files A and B (to determine whether to display the ""Upload Print Images" button", "receives a printing order," controls the "printing setting, such as a quality and a print size" for an image file that was uploaded by a user for printing, and invoices a user based on printer settings that are applied to the uploaded image file (the "selected distribution route service ... and the selected privilege service"). As explained above, nowhere does Tanaka

describe that the image file which is uploaded by a user is analyzed to control routing of the image file.

The Examiner is entirely silent as to pointing out any disagreement with Applicant's explanation in the Brief on Appeal as to why Madison does not supply any of the teachings that are missing from Tanaka. In particular, in rejecting the subject matter of Claim 21, the Final Office Action on page 9 concedes that "Berard does not disclose expressly searching the content of the file to identify one or more keywords that are defined by a routing policy or selectively renaming the file based on the identified keywords." In the an attempt to supply some of the missing recitations, the Final Office Action contends on page 8 that "Tanaka discloses searching the content of a file to identify keywords defining a routing policy for the file." However, as explained above, Tanaka analyzes the contents of a magazine supplied setting file (which is not printed), not the contents of a separate user supplied image file that is to be printed.

The Final Office Action also contends on page 8 that "Madison discloses renaming a file based upon the data within the file, such as XML data indicating a successful or unsuccessful file upload, and a routing policy, such as the value of the XML data updated according to the result of the upload attempt." Appellant acknowledges that Madison discloses that a file is selectively renamed in response to whether it was successfully uploaded. However, nowhere does Madison appear to disclose that a file is selectively renamed in response to what that file contains, or, much less, that a print file is selectively renamed in response to identifying within the print file one or more keywords that are defined by a routing policy.

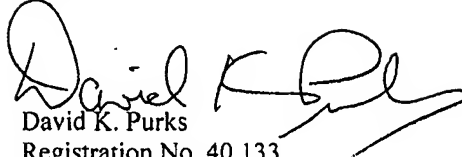
Accordingly, a *prima facie* case of obviousness over Berard in view of Tanaka and Madison has not been made, and the rejection of Claim 21 under 35 USC §103(a) should be reversed.

III. CONCLUSION

In light of the above discussion, Appellant submits that the pending claims are patentable over the cited references and, therefore, requests reversal of the rejections of Claims 2-10 and 12-21 and passing of the application to issue.

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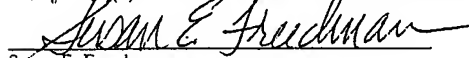
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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on April 3, 2009.


Susan E. Freedman
Date of Signature: April 3, 2009